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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/667,732	09/22/2003	Sang Chul Kang	JP920020142US1	9679
23550	7590	05/30/2008	EXAMINER	
HOFFMAN WARNICK LLC 75 STATE STREET 14TH FLOOR ALBANY, NY 12207				LE, KHANH H
ART UNIT		PAPER NUMBER		
3688				
			NOTIFICATION DATE	DELIVERY MODE
			05/30/2008	ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

PTOCommunications@hwdpatents.com

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/667,732	KANG ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	KHANH H. LE	3688	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 02/26/2008.
- 2a) This action is **FINAL**.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-18 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ .                                    |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ .  | 6) <input type="checkbox"/> Other: _____ .                        |

## **DETAILED ACTION**

1. This Office Action is in response to the Amendment and Response filed on 02/26/2008 which has been entered. Claims 1-18 are currently pending and considered below. Claims 1, 2, 9, 10, 17, 18 are independent.

### **Remarks**

**2. Specification, (at [0004] of US PGPub. 20040059632 version):**

*“In this regard, co-pending U.S. patent application Ser. No. (IBM docket No. JP9-2001-0343), which is commonly assigned and is incorporated by reference herein, ..”*

**should be amended to**

*“In this regard, co-pending U.S. patent application Ser. No. 10/263,217 (IBM docket No. JP9-2001-0343), which is commonly assigned and is incorporated by reference herein, ..”*

If Ser. No 10/263,217 issues as patent, the incorporation should refer to the patent number too.

### **Response to Arguments**

3. Applicant's arguments have been fully considered but they are not persuasive. New grounds of rejection follow, with responses included therein.

***Claim Rejections - 35 USC § 103***

**4.** The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

**5. Claims 1-6, 8-14, 16-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hoyle US 6,141,010 A in view of Blaser US 675766.**

**Independent claims 1, 9 and 17 and dependent claim 8:**

**Hoyle discloses:**

A method, system and computer readable medium stored thereon program instructions executable by a computer to perform providing an advertisement to a user over the Internet, the method comprising the steps of:

*obtaining (by storing operation unit which operates the CPU-- Figure 1 item 14 and associated text; col. 6 line 62 to col. 7 line 13) from a first server (Figure 1 item 22 : ADM server 2; col. 8 lines 30-40) a plurality of web page URLs (Figure 7 item “associated links” and associated text)*

*and associated advertisement information for each of the web page URLs (Figure 7 and associated text; e.g. “destination links”, “categories”), said advertisement information including an address at which associated advertisement data is stored (Figure 7, item “destination links”, and associated text; col.16 lines 24-37) ;*

and storing (*by the storing operation unit which operates the CPU-- Figure 1 item 14 and associated text; col. 6 line 62 to col. 7 line 13*) said advertisement information in a local storage (“Banner storage” item 30 in user computer 18 in Figures 1, 2 or 4 and associated text; Figure 7 and associated text)

detecting (*by a detecting operation unit which operates the CPU--Figure 1 item 14; col. 6 line 62 to col. 7 line 13*) an URL that the user enters on a web browser (col.16 lines 24-37: ‘recognizing the website being accessed’ );

retrieving (*by a retrieving operation unit which operates the CPU --Figure 1; col. 6 line 62 to col. 7 line 13*) from the local storage the advertisement information associated with the detected URL (col.16 lines 24-37);

reading from a **second server, the second server being the same as the first server** (Figure 3 item 22: ADM server 22; col.16 lines 37-52 ) the associated advertisement data at the advertisement address included in the retrieved advertisement information (col. 16 lines 37-52);

and displaying (*by a displaying operation unit which operates the CPU--Figure 1 item 12; col. 6 line 62 to col. 7 line 13*) the associated advertisement data in accordance with the advertisement information (col. 16 line 35).

**Hoyle does not disclose the ad server being different than the ad control server as now claimed.**

**Further, Applicant(s) argue(s):** “*Regarding independent claim 1, Hoyle fails to disclose, inter alia,*  
“*reading from the advertisement server the associated advertisement data at the advertisement address included in the retrieved advertisement information, and providing the associated advertisement data from the advertisement server to the user computer over the Internet; and displaying the associated advertisement data in accordance with the advertisement information.” On the contrary, in Hoyle, banner advertisements are locally stored on the end user's computer 18 in banner storage 30.”*

**However Blaser US 6757661 discloses** monitoring user activities including targeted URLs or search terms and sending “ads objects” based on detecting such targeted user activities. “Ad objects” are “data constructs which each include a resource locator of an advertisement to be displayed”. (col. 17 lines 47). The association of the **targeted Url or search**

**terms** to the ad objects are stored at the host server (col. 17 lines 47) and also at the user computer (col. 17 lines 9-16; col. 18 lines 37-42) for fast access (col. 18 lines 41-42).

Thus Blaser teaches accessing an ad server over the internet to retrieve the advertisement by clicking on “a resource locator of [the] advertisement to be displayed”.

Thus it would have been obvious to a person having ordinary skill in the art at the time the invention was made (herein a “PHOSITA”) to substitute to Hoyle’s ad (stored locally) the “resource locator of [the] advertisement to be displayed” of Blaser (also stored locally), if it is needed or more efficient for the system to store the ads at another server than locally.

**As throughout Blaser, many advertisers are mentioned, it is clear that other ad servers may be involved. Further it is admitted that the advertisement server may be one and the same as the advertisement control server.**

( See Specification at [0027] “*The advertisement control server 150 includes an advertisement lookup source database 156 and an advertisement control information source database 158, which correspond to the advertisement lookup database 136 and the advertisement control information database 138 of the user computer 110, respectively. Those skilled in the art will easily recognize that the advertisement server 140 and the advertisement control server 150 can be implemented at the same server, although there is depicted in FIG. 1 that they have been implemented at physically separated servers.* “).

Thus Hoyle in view of Blaser discloses as much as the specification.

#### **Independent claims 2, 10 and 18 and dependent claim 16:**

##### **Hoyle discloses:**

A method, system and computer readable medium stored thereon program instructions executable by a computer to perform providing an advertisement to a user over the Internet, the method comprising the steps of:

obtaining from a first server (Figure 1 item 22 : ADM server 2; col. 8 lines 30-40) a plurality of web page URLs (Figure 7 item “associated links” and associated text) and associated advertisement information for each of the web page URLs (Figure 7 and associated text; e.g.

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“destination links”, “categories”), said advertisement information including an address at which associated advertisement data is stored (Figure 7, item “destination links”, and associated text; col.16 lines 24-37);

and storing (*by the storing operation unit which operates the CPU-- Figure 1 item 14 and associated text; col. 6 line 62 to col. 7 line 13*) said advertisement information in a local storage (“Banner storage” item 30 in user computer 18 in Figures 1, 2 or 4 and associated text; Figure 7 and associated text);

**detecting** (*by a detecting operation unit which operates the CPU--Figure 1 item 14; col. 6 line 62 to col. 7 line 13*) **an URL and a search keyword** that the user enters on a web browser (col.16 lines 24-37: ‘recognizing.. the website being accessed,,the keywords used’);

*retrieving (by a retrieving operation unit which operates the CPU --Figure 1; col. 6 line 62 to col. 7 line 13)* from the local storage the advertisement information associated with the detected URL (col.16 lines 24-37);

reading from a **second server, the second server being the same as the first server** (Figure 3 item 22: ADM server 22; col.16 lines 37-52 ) the associated advertisement data at the advertisement address included in the retrieved advertisement information (col. 16 lines 37-52);

*and displaying (by a displaying operation unit which operates the CPU--Figure 1 item 12; col. 6 line 62 to col. 7 line 13)* the associated advertisement data in accordance with the advertisement information (col. 16 line 35).

**Hoyle does not disclose the ad server being different than the ad control server as now claimed.**

**Further, Applicant(s) argue(s):** “*Regarding independent claim 1, Hoyle fails to disclose, inter alia, "reading from the advertisement server the associated advertisement data at the advertisement address included in the retrieved advertisement information, and providing the associated advertisement data from the advertisement server to the user computer over the Internet; and displaying the associated advertisement data in accordance with the advertisement information." On the contrary, in Hoyle, banner advertisements are locally stored on the end user's computer 18 in banner storage 30.”*

**However Blaser US 6757661 discloses** monitoring user activities including targeted Urls or search terms and sending “ ads objects” based on detecting such targeted user activities. “Ad

objects” are “data constructs which each include a resource locator of an advertisement to be displayed”. (col. 17 lines 47). The association of the ***targeted Url or search terms*** to the ad objects are stored at the host server (col. 17 lines 47) and also at the user computer (col. 17 lines 9-16; col. 18 lines 37-42) for fast access (col. 18 lines 41-42).

Thus Blaser teaches accessing an ad server over the internet to retrieve the advertisement by clicking on “a resource locator of [the] advertisement to be displayed”.

Thus it would have been obvious to a person having ordinary skill in the art at the time the invention was made (herein a “PHOSITA”) to substitute to Hoyle’s ad (stored locally) the “resource locator of [the] advertisement to be displayed” of Blaser (also stored locally), if it is needed or more efficient for the system to store the ads at another server than locally. As throughout Blaser, many advertisers are mentioned, it is clear that other ad servers may be involved. Further it is admitted that the advertisement server may be one and the same as the advertisement control server.

( See Specification at [0027] “*The advertisement control server 150 includes an advertisement lookup source database 156 and an advertisement control information source database 158, which correspond to the advertisement lookup database 136 and the advertisement control information database 138 of the user computer 110, respectively. Those skilled in the art will easily recognize that the advertisement server 140 and the advertisement control server 150 can be implemented at the same server, although there is depicted in FIG. 1 that they have been implemented at physically separated servers.* “).

Thus Hoyle in view of Blaser discloses as much as the specification.

#### **Claims 3-4 and 11-12:**

HOYLE in view of Blaser disclose a method and system as in Claims 1-2 and 9-10 above and HOYLE further discloses wherein the web page URLs and the search keywords are represented by regular expressions (Figure 3, e.g. URL is www.sports.com; keyword is sports or stocks).

*(Note: Since the only relevant paragraph [0031] of the published version of the specification-- US 20040143496-- fails to specifically define " regular expressions" , this phrase is interpreted as any expression such as a English terms e.g. "sports").*

**Claims 5 and 13:**

HOYLE in view of Blaser disclose a method and system as in Claims 1 and 9 above and HOYLE further discloses the ad data includes other data including a number of times a particular ad can be displayed (col. 15 lines 54-58; col. 12 lines 5-6).

Hoyle however does not specifically disclose the ad information includes information on an effective display period of time.

However an “effective display period of time” is only a common alternative for a number of times of display, for the same purpose of limiting the time of exposure of a particular ad so others can be displayed (Hoyle, col. 15 lines 58-59). Because it is obvious to use common alternative means to achieve the same goal, if desired, it would have been obvious to a person having ordinary skill in the art at the time the invention was made (herein a “PHOSITA”) to replace Hoyle’s number of times of display for an ad with an “effective display period of time”.

Also, Hoyle does not specifically disclose display location information of the advertisement. However it discloses a banner region 78 (col. 9 lines 26-57; Figure 5 item 78), and the ad data can includes other specifying data (col. 15 lines 54-55). Thus it would have been obvious to a PHOSITA to add to Hoyle’s ad data display location information of the ad to effect displaying the ad in the desired user screen region. As discussed in Hoyle, such display control techniques as well-known (col. 9 lines 26-57), thus obvious to implement.

**Claims 6 and 14:**

HOYLE in view of Blaser modified as above discussed disclose a method and system as in Claims 5 and 13 above and HOYLE further discloses wherein determining if the effective display period of time for the advertisement to be displayed has expired (col. 12 lines 5-6).

It is argued : “*For example, with regard to dependent claim 6 (and similarly dependent claim) 14, Hoyle/Nicholas fail to disclose "wherein said step of displaying further comprises the*

*step of checking a validity of the advertisement by determining if the effective display period of time for the advertisement to be displayed has expired."*

However, Hoyle, col. 12 lines 5-6, discloses an allotted number of times to display each ad, and mentions a timer, thus this reads on "*determining if the effective display period of time for the advertisement to be displayed has expired*".

Further Blaser also discloses ads being changed after a certain period of time.

See, e.g., Blaser, Brief Summary Text - BSTX (13):

*Some online service providers have derived revenue by displaying advertisements for third parties (hereinafter, "advertisements") to users. For example, when a user accesses a web page on the Web, an advertisement may be displayed to the user as part of the web page. Advertisements are also shown to users of some proprietary online services. Typically in such systems, each user accessing a certain screen or site is shown the same advertisement.*

**Sophisticated systems have the capability to change the advertisement after a certain period of time.**

Thus the feature is well-known before invention and incorporating old elements (i.e. adding this teaching of Blaser to Hoyle in view of Blaser) has been held obvious. See “Examination Guidelines for Determining Obviousness Under 35 U.S.C. 103 in View of the Supreme Court Decision in KSR International Co. v. Teleflex Inc., Federal Register / Vol. 72, No. 195 / Wednesday, October 10, 2007 Notices, <http://www.uspto.gov/web/offices/com/sol/notices/72fr57526.pdf> (herein “Guidelines”)

**7. Claims 7 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hoyle in view of Blaser as applied to claims 5 and 13 above, and further in view of Nicholas III, US 6,865,719.**

**Claims 7 and 15:**

HOYLE in view of Blaser modified as above discussed disclose a method and system as in Claims 5 and 13 above.

However, Hoyle does not disclose wherein said step of displaying further comprises the step of determining if the advertisement will be displayed within a web browser or outside the web browser, based on the display location information.

However, Nicholas discloses ads shown inside or outside of the browser (Figure 4A items 408 and associated text; col. 7 lines 55 col. 8 line 8). It would have been obvious to a PHOSITA to add this teaching of Nicholas to Hoyle to allow the ad to display where the user ‘s focus is best (Nicholas, col. 2 lines 53-67).

### ***Conclusion***

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Wolfe US 6336131 B1 discloses second server to serve ads.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Khanh H. Le whose telephone number is 571-272-6721. The Examiner works a part-time schedule and can normally be reached on Tuesday-Wednesday 9:00-6:00.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, James W. Myhre can be reached on 571-272-6722. The fax phone numbers for the organization where this application or proceeding is assigned are **571-273-8300** for regular

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communications and for After Final communications. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 571-272-3600. For patent related correspondence, hand carry deliveries must be made to the Customer Service Window (now located at the Randolph Building, 401 Dulany Street, Alexandria, VA 22314). Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Khanh H. Le/  
Examiner, Art Unit 3688  
May 23, 2008

/James W Myhre/  
Supervisory Patent Examiner, Art Unit 3688